

## **REMARKS/ARGUMENTS**

### **I. Fees**

*If there are any additional fees due in respect to this amendment, please charge them to Deposit Account No. 13-2165. Authority is hereby given to charge any such deficiency, or credit any overpayment, to Deposit Account No. 13-2165 Mathews, Collins, Shepherd & McKay. The Examiner is invited to contact the undersigned if further information is required.*

### **II. Information Disclosure Statement**

The Examiner notes that with respect to the Applicant's IDS filed on October 6, 2003 that the only non-patent literature found was the Nichia America brochure. Any omission of the non-patent documents is a result of an obvious clerical error. The Applicant herein submits a duplicate copy of the four non-patent documents which could not be found with a duplicate 1449 and requests that the references be considered.

### **III. Priority**

The Applicant has amended the paragraph to reflect the issuance of the parent application and filing date.

### **IV. Rejection under 35 U.S.C. §102(e)**

The Examiner has rejected claim 38 over Cooper *et al.*, U.S. Patent No. 6,491,408 (hereinafter "Cooper"), under 35 U.S.C. §102(e). The rejection thereby implicitly asserts that:

"the invention [of claim 38] was described in ... (2) a patent by another filed in the United States before the invention by the applicant for patent ....

Applicant respectfully submits that there are at least three reasons, each independent of the other, why this rejection should be withdrawn and the requested interference should be declared forthwith, to wit:

- (i) Where the "patent by another" claims (as opposed to merely disclosing) the subject invention, an asserted anticipation under 35 U.S.C. §102(e) is subsumed in the issue of priority arising under 35 U.S.C. §103(g) and 35 U.S.C. §135;
- (ii) Cooper does not "describe" the subject matter of claim 38 in accordance with 35 U.S.C. §112, first paragraph, as is required in order to constitute an anticipation; and
- (iii) Applicant herein demonstrates priority in accordance with the provisions of 37 CFR §1.131.

(a) **An Asserted Anticipation under 35 U.S.C. §102(e) Is Subsumed in the Issue of Priority under 35 U.S.C. §102(g) and 35 U.S.C. §135**

If Applicant prevails in the interference by establishing priority over Cooper, it necessarily means that Applicant has been found to have made the invention before Cooper. A rejection under 35 U.S.C. §102(e) then would be superfluous, if not improper.

If, on the other hand, Cooper were to prevail in the interference, the issue of anticipation of Applicant's claim 38 under 35 U.S.C. §102(e) becomes moot.

Thus the resolution of priority under 35 U.S.C. §102(g) completely disposes of any issue under 35 U.S.C. §102(e).

The converse, however, is not true. Overcoming the rejection under 35 U.S.C. §102(e) will not resolve the priority issue under 35 U.S.C. §102(g). Resolution of the latter through an interference will be required even after a 35 U.S.C. §102(e) rejection is overcome. This is so

because whereas the §102(e) rejection is predicated on the assertion that the patentee discloses the invention in his specification, here the patentee actually claims that invention.<sup>1</sup>

Thus prosecutorial efficiency would suggest the issue of priority under 35 U.S.C. §102(g) should be decided directly.

Applicant himself brought the issue of priority to the Examiner's attention and in doing so, complied with every provision of 37 CFR §1.608(a) in order to provoke a requested interference. That showing effectively negated 35 U.S.C. §102(e) by properly invoking 35 U.S.C. §102(g) and §135.<sup>2</sup>

**(b) Cooper Does Not Describe the Subject Matter of Claim 38 in Accordance with 35 U.S.C. §112.**

For an application to constitute a constructive reduction to practice, its disclosure must satisfy the description and enablement requirements of the first paragraph of 35 USC §112. *Eiselstein v. Frank*, 52 F.3d 1035, 34 USPQ2d 1467 (Fed. Cir. 1995); *Weil v. Fritz*, 572 F.2d 856, 862-63, 196 USPQ 600, 603 (CCPA 1978); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978); *In re Gosteli et al.*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *Kawai v. Metlesic*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).<sup>3</sup>

In the present situation, the Examiner has asserted anticipation and has not asserted obviousness. In discussing the alleged anticipation, however, the Examiner does not refer to the written description in Cooper's specification, referring only to Figure 5A of the patent.

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<sup>1</sup> As will be shown *infra*, Cooper's specification in fact does not describe the relevant subject matter under 35 U.S.C. §112.

<sup>2</sup> Since Applicant filed within 7 days of Cooper, 37 CFR §1.608(b) does not apply and a showing thereunder is not required.

<sup>3</sup> In the context of an interference, the disclosure need not comply with the best mode requirements of 35 USC §112. *Cromlish v. D.Y.* 57 USPQ2d 1318 (Bd. Pat. App. & Intf. 2000),

It is of course true that a patent drawing may provide sufficient disclosure to comply with the description requirements of 35 U.S.C. §112. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). It is also true, however, that for a reference to anticipate by reason of its written description, drawing, or original claims, it must describe every claimed component of the invention. *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120, 65 USPQ2d 1051 (Fed. Cir. 2002). The reference in doing so must satisfy what the Court of Appeals for the Federal Circuit has called "the strict identity" test for novelty. Thus a color printer did not anticipate a claim requiring, *inter alia*, a color photocopier:

The difference between a printer and a photocopier may be minimal and obvious to those of skill in this art. Nevertheless, obviousness is not inherent anticipation.

*Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984)

As will be seen herein, the disclosure of Cooper may be "close" but it does not constitute an anticipation.

In order to determine if anticipation is present, the Cooper patent must be examined in its entirety. Thus Figure 5A upon which the Examiner relies cannot be considered in a vacuum but must be considered in the context of (1) the actual text making reference to it and (2) Figure 5B which is associated with it.

Element "30", what the Official Action refers to as "a light head", in fact is a lamp housing. Three LEDs "28" are disposed within lamp housing "30".

The Office Action refers to these three LEDs "being capable of emitting UV/blue LED light", citing column 6, lines 15-16, but that passage refers to a different embodiment, that of Figure 8 having, *inter alia*, an extendible or telescoping handle 67.

In the embodiment of Figures 5A and 5B, however, upon which the Office Action relies

as anticipation, the three LEDs are blocked by rotatable cover 44 having

... an aperture suitable for only one LED for selectively blocking the light from two of the LEDs so that only the light from one LED is emitted from the inspection lamp at any one time. [Col. 4, lines 59-63]

As a first modification, therefore, one would have to remove this cover structure and substitute either Applicant's LED capable of emitting UV/blue LED light or an LED from another embodiment having different structural elements.

Moreover the actual disclosure of Cooper associated with Figures 5A and 5B does not refer to a main body "36" and an elongated flexible stalk "32" but rather to "an extendible handle" 26 that has an upper flexible portion and a lower rigid portion 36. Cooper repeatedly refers to "an extendible handle" as one that can be "inserted deeply into tight areas" [col. 3, lines 4-5], as being "adapted to slidably engage around the housing" [col. 4, lines 16-17; or as being telescoping [col. 5, line 60, and col. 5, lines 66-67]. Flexible is not a subset of extendible, it is a different structure; *e.g.*, a telescope is extendible, it is not flexible; a rope is flexible, it is not extendible. An "extendible handle having an upper flexible portion" similarly is not the same as "an elongated flexible stalk". It may (or may not) be obvious under 35 U.S.C. §103 but it does not satisfy "the strict identity" test required for anticipation under 35 U.S.C. §102.<sup>4</sup>

Finally while the Examiner asserts that Cooper discloses that "bending the flexible stalk permits the light head to assume a variety of angular positions," no such disclosure appears in connection with Figures 5A and 5B. Rather Cooper discloses only that "upper flexible portion 32 can be folded onto rigid portion 36 to shorten the length of the inspection lamp." Again the Examiner may assert that the difference is obvious but that consideration arises under 35 U.S.C. §103, not 35 U.S.C. §102. Cooper, for example, refers to a jack knife configuration as another

means for "extending" the inspection lamp so that it is "folded in half and locked when not in use." [col. 6, lines 55-60]. Thus the mere possibility that "upper flexible portion 32 can be folded onto rigid portion 36 to shorten the length of the inspection lamp" is not a disclosure that the flexible stalk can be bent to permit the light head to assume a variety of angular positions.

The difficulty the Examiner apparently encountered in finding a description of the subject matter necessary to frame a proper rejection of Applicant's claims under 35 U.S.C. §102(e) arises because the claimed subject matter simply is not described by Cooper's written specification, his drawings, or his original claims.

It is Applicant's position that in fact Cooper added claims only after learning of the Applicant's device. Such an asserted derivation, if proven, cannot be resolved under 35 U.S.C. §102(e) but must be resolved through an interference under 35 U.S.C. §102(g).

That this matter is more properly resolved under 35 U.S.C. §102(g) rather than 35 U.S.C. §102(e) is also clear from the fact that 37 CFR §1.601(n) expressly authorizes an interference where the claimed inventions are not identical but are obvious under 35 U.S.C. §103; an anticipation under 35 U.S.C. §102(e) on the other hand requires "strict identity" which, as demonstrated above, does not exist here.

- (c) **Applicant Demonstrates Herein Under the Provisions of 37 CFR §1.131**  
**That:** (i) **He Conceived of the Invention Prior to July 5, 2001;**  
(ii) **The Invention Was Actually Reduced to Practice on his**  
**Behalf Prior to July 5, 2001; and**  
(iii) **Diligence Was Exercised on His Behalf from Just Prior to**  
**July 5, 2001 to July 12, 2001 When the Invention Was**  
**Constructively Reduced to Practice.**

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<sup>4</sup> Note also that Figure 6A and 6B, not here relied upon, describes "extendible handle 46 which is at least part flexible" [col. 5, line 7-8]; i.e., two separate properties.

To establish priority, one must show reduction to practice of the invention before the opponent, or prior conception coupled with reasonable diligence from just prior to the other party's effective date to a subsequent reduction to practice. *Hyatt v. Boone*, 146 F.3d 1348, 1351, 47 USPQ.2d 1128, 1129 (Fed. Cir. 1998); *Paulik v. Rizkalla*, 760 F.2d 1270, 1272, 226 USPQ.224, 225 (Fed. Cir. 1985) (en banc); *Scott v. Finney*, 34 F.3d 1058, 1061, 32 USPQ.2d 1115, 1117 (Fed. Cir. 1994).

The Examiner's attention is respectfully drawn to the declarations under 37 CFR §1.131 of Robert Cacciabeve<sup>5</sup>, Robert Gilbert and David Peter Krivoshik which are attached hereto. First Applicant demonstrates herein the prior disclosure and actual reduction to practice of the invention prior to July 5, 2001. That is a working prototype was prepared on Applicant's instruction and imported into this country. That importation of the completed invention prepared abroad at the request of the inventor, establishes possession of the invention prior to the earliest possible date of the §102(e) reference.

Independent of this actual reduction to practice, Applicant provides evidence of (1) prior conception, namely the existence of the disclosure of Applicant's provision application prior to July 5, 2001, coupled with (2) diligence to the constructive reduction to practice seven days later on July 12, 2001.

Under either set of facts, the reference has been overcome. Withdrawal of the rejection of claim 38 over Cooper *et al.*, U.S. Patent No. 6,491,408 (hereinafter "Cooper"), under 35 U.S.C. §102(e) is respectfully requested.

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<sup>5</sup> None of these individuals is an inventor and thus none needs corroboration. *DeSolms v. Schoenwald*, 15 USPQ 1507, 1509 (Bd. Pat. App. & Int'f. 1990)

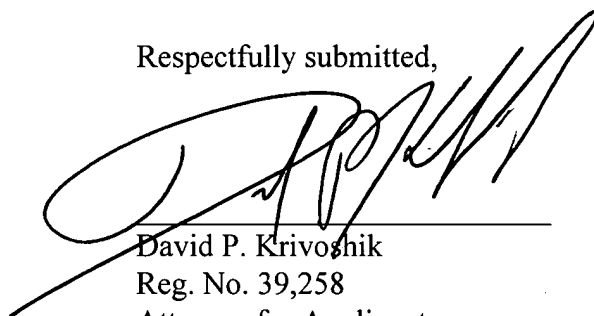
**V. Request for Interference Under 37 CFR §§ 1.607 and 1.608(a)**

Applicant again respectfully requests an interference with U.S. Patent No. 6,491,408 (“Cooper *et al.*”) and incorporates the previous Request for Interference Pursuant to the provisions of 37 CFR §1.607 and §1.608(a) herein as if it were set out in full including the declaration under 37 C.F.R. §1.608(a) as set out the preliminary amendment.

**VI. SUMMARY**

Prompt declaration of the requested interference between Applicant’s claim 38 and Cooper et al. claims 6-10 and 14 is respectfully requested.

Respectfully submitted,



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